

REMARKS

By this Amendment, claims 14-23, 31-35, 41 and 44 are cancelled, claims 24, 36 and 43 are amended, and new claims 45-48 are added. On entering this amendment, claims 24-30, 36-40, 42, 43 and 45-48 are pending in the present application. Applicant respectfully requests withdrawal of the rejections and allowance of the claims.

I. Restriction

The Examiner indicates that claims 14-23, 31-35, 41 and 44 are finally restricted and withdrawn from consideration. Applicant thanks the Examiner for indicating the finality of the restriction. Accordingly, Applicant has cancelled those claims, as shown in the foregoing amendments.

II. Formalities

As shown on Form PTO-948, the Draftsperson objects to the drawings under 37 C.F.R. § 1.84(l). Applicant respectfully submits that the formal drawings submitted on October 31, 2000, overcome the draftsperson's objections, and that the Form PTO-948 provided in the present Office Action is the same Form PTO-948 provided in the August 1, 2000 Office Action. Accordingly, Applicant respectfully submits that the drawings are in proper condition.

Applicant also thanks the Examiner for providing initialed copies of Form PTO-1449 for the Information Disclosure Statements filed January 8 and February 16, 2000, and June 19, 2000.

Applicant also thanks the Examiner for withdrawing the rejections based on Macor, Brandenburg, JP-06-90200 and Ishida. However, Applicant respectfully submits that the claimed invention is also patentably distinct from the references cited in the present Office Action, for at least the reasons discussed in greater detail below.

III. Claims 24-30 and 43 are novel

Claims 24-30 and 43 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Sudo et al. (U.S. Patent No. 5,987,336, hereafter “Sudo”). Applicant respectfully submits that Sudo fails to disclose all of the claimed combination of features recited in claims 24-30 and 43, as required for a rejection under §102. Thus, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

Sudo discloses a communication terminal apparatus and control method thereof. As illustrated in Figure 26 of Sudo, a cursor can be moved based on the operation of a scroll 36J that permits the cursor to be moved in an up direction or a down direction, thus enabling two-way movement of the cursor. Thus, Sudo does not disclose four way movement (i.e., up, down, left and right) of a highlight bar by the scroll 36J.

Further, to continue scrolling in the same direction, a user must substantially reposition their finger on the scroll. For example, but not by way of limitation, if the user is scrolling down, once their finger is positioned at the bottom of the scroll 36J, the finger must be substantially repositioned on the scroll 36J to continue scrolling in the downward direction. Thus, Sudo does not performing movement of a highlight bar and execution of a task without substantial repositioning of a finger of a user. By depressing (i.e., clicking) the scroll 36J when the user repositions their finger in the center of the scroll 36J, a call can be initiated.

Applicant respectfully submits that Sudo fails to disclose that an input device enables four-way movement of said highlight bar as recited in independent claim 24, or a movement key that is configured to move in four directions, as recited in independent claim 43. As noted above,

Sudo only discloses a movement key that is configured to move in two directions (i.e., up or down).

Further, Applicant respectfully submits that Sudo fails to disclose that said user input comprises a user body part contacting said input device, and that said moving and executing is performed without substantial repositioning of a user body part as recited in independent claim 24, or said user input comprising a user body part contacting said input device, and said moving and executing is performed without substantial repositioning of a user body part that contacts the movement key and the execution key, as recited in independent claim 43. For at least the reasons provided above, Applicant submits that Sudo, unlike the present invention, requires substantial repositioning of the finger for the selection and execution of a highlighted item.

Claims 25-30 depend from independent claim 24. Applicant respectfully submits that those dependent claims are allowable for at least the same reasons as discussed above with respect to independent claim 24. Thus, Applicant respectfully requests withdrawal of the §102 rejection, and allowance of the claims.

IV. Claims 36-39, 40 and 42 would not have been obvious

Claims 36-39 and 42 stand rejected due to alleged obviousness under 35 U.S.C. § 103(a) over Sudo in view of Davidson et al. (U.S. Patent No. 5,774,540, hereafter “Davidson”), and claim 40 stands rejected under §103 over Sudo and Davidson in view of Japanese Patent publication JP-06-232992 (hereafter “JP ‘992”). Applicant respectfully submits that the Examiner’s proposed combination of references fails to disclose or suggest all of the claimed

combination of references, as required for establishing a prima facie rejection. Thus, Applicant respectfully requests withdrawal of the rejection and allowance of the claims.

A. Claims 36-39 and 42 would not have been obvious

Davidson discloses an interface for displaying and accessing telephone terminal features. Davidson discloses a select button 222 positioned between a back button 221 and a next button 223. Due to the position of the back button 221 and the next button 223, Applicant respectfully submits that a user must substantially reposition their finger to switch between using the back button 221 and the next button 223. Thus, Applicant respectfully submits that Davidson does not disclose or suggest an input device configured to permit four-way movement of a highlight bar, or operation of a movement keypad and an execution key without substantial repositioning of a user's finger.

Applicant respectfully submits that the Examiner's proposed combination of references fails to disclose or suggest a movement key pad that allows four-way movement among a group of information items, as recited in independent claim 36. As noted above, the back key 221 and the next key 223 of Davidson only permit two-way movement of information items, and Davidson does not teach or suggest four way movement, as recited in claim 36. Because Sudo also only teaches two-way movement and does not teach or suggest four-way movement, Applicant respectfully submits that the Examiner's proposed combination of references fails to teach or suggest four way movement, as recited in independent claim 36.

Additionally, Applicant respectfully submits that the Examiner's proposed combination of references fails to teach or suggest that said movement key pad and said execution key are

operated without requiring a user to substantially reposition a user body part that contacts said first key section, as recited in independent claim 36. As noted above, Davidson requires repositioning of the user finger between the back button 221 and the next button 223, and Sudo requires repositioning of the user finger on the scroll 36J to perform movement and/or execution.

Further, as admitted by the Examiner, Sudo fails to disclose that the first and second key sections are adjacent to one another on one side, as recited in independent claim 36. The Examiner argues that under Japikse, mere movement of a feature from one portion of a device to another portion of a device would have been obvious, and applies that rationale to modify Sudo. In re Japikse, 86 USPQ 70 (CCPA 1950) Applicant respectfully submits that the Examiner has misapplied Japikse to the present application, and has thus provided improper motivation to modify the cited references. Applicant notes that Japikse only applies where the modification would not have modified operation of the device. Further, as noted at MPEP § 2144.04.VI.C and in Ex parte Chicago, 223 USPQ 351, 353 (BPAI, 1984), the mere fact that parts of a reference device can be rearranged to meet the terms of a claim “is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without benefit of appellant’s specification, to make the necessary changes in the reference device.” (emphasis added) Applicant respectfully submits that the Sudo alone fails to provide any motivation to move the scroll 36J to the same side as the keypad 36B. Further, Applicant respectfully submits that such a modification might result in making the Sudo device inoperable without substantial changes.

Claims 37-39 and 42 depend from independent claim 36. Applicant respectfully submits that those dependent claims are allowable for at least the same reasons discussed above with respect to independent claim 36. Thus, Applicant respectfully requests withdrawal of the §103 rejection, and allowance of the claims.

B. Claim 40 would not have been obvious

Claim 40 depends from independent claim 36. Applicant respectfully submits that dependent claim 40 is allowable for at least the same reasons as discussed above with respect to independent claim 36. Further, Applicant respectfully submits that claim 40 is allowable for at least the additional reasons discussed below.

JP '992 discloses a telephone receivers that controls an electronic computer. Applicant respectfully submits that JP '992 fails to disclose or suggest a depression switch contact that is closed by depressing a single lever-type key, as recited in claim 40. Thus, Applicant respectfully requests withdrawal of the §103 rejection, and allowance of claim 40.

V. New claims 45-48 are allowable

As shown in the foregoing amendments, Applicant has added new claims 45-48 to recite additional features of the present invention. Claims 45 and 46 depend from independent claim 24, claim 47 depends from independent claim 36, and claim 48 depends from independent claim 43. Applicant respectfully submits that new dependent claims 45-48 are allowable for at least the same reasons as the claims from which they depend. Thus, Applicant respectfully requests allowance of new claims 45-48.

VI. Conclusion

Amendment Under 37 C.F.R. § 1.111
U.S. Appln. No. 09/192,303

Reconsideration and allowance of all claims are respectfully requested in view of the following remarks. In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 14-23, 31-35, 41 and 44 are canceled.

The claims are amended as follows:

24. (Amended) A method for performing a task in a communication device, comprising:
displaying, in a first user interface on a housing having a second user interface on a same side as the first user interface, a menu having a plurality of items and a highlight bar;
moving said highlight bar to select an item in response to a user input to an input device coupled to said display enabling four-way movement of said highlight bar; and
executing a task in response to said selected item, wherein said input device comprises a first part positioned on said same side of said housing as said first user interface [and said first user interface is a display and said second user interface transmits sound waves], said user input comprises a user body part contacting said input device, and said moving and executing is performed without substantial repositioning of a finger of a user.

36. (Amended) A portable communication apparatus having a display section and a key operation section [and a key operation section] on one side of a housing, the key operation section comprising:

a first key section including a movement key pad which is used to move a highlighted portion indicating one of a plurality of information items displayed in the display section, and an execution key used to executed a highlighted information item; and

a second key section including a ten key pad, wherein the first key section and the second key section are adjacent to each other on the one side,

wherein the movement key pad and the execution key are disposed within an area of the first key operation section immediately below the display section,

wherein the display section displays a plurality of information items in a plurality of rows and columns, and

wherein the movement key pad allows [only]four-way movement among a group of information items on a column in which the highlighted portion exists to be scrolled, and said movement key pad and said execution key are operated without requiring a user to substantially reposition a user body part that contacts said first key section.

43. (Amended) A method for selecting one of a plurality of information items, which is displayed in a plurality of row and columns on a display section of a portable communication apparatus, the method comprising:

moving a highlighted portion to a desired information item of the plurality of information items displayed in the display section by operating a movement key that is configured to move said highlighted portion in four directions, wherein only a group of information items on a column in which the highlighted portion exists is allowed to be scrolled as necessary; and

executing the desired information item on the highlighted portion by operating an execution key, wherein said moving and executing is performed without substantial repositioning of a user body part that contacts said movement key and said execution key.

Please add the following new claims:

--45. (New) The method of claim 24, wherein said first user interface is a display and said second user interface transmits sound waves.--

--46. (New) The method of claim 24, wherein said movement and execution are performed without removing said body part from said input device.--

--47. (New) The method of claim 36, wherein said movement key pad and said execution key are operated without removing said body part from said first key section.--

--48. (New) The method of claim 43, wherein said moving and said executing are performed without removing said body part from said movement key and said execution key, respectively.--